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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,574	09/14/2001	Thomas D. Lyster	US010599	7222

28159 7590 11/22/2005

PHILIPS MEDICAL SYSTEMS  
PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT PAPER NUMBER

3762

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/954,574	<b>Applicant(s)</b> LYSTER ET AL.	
	<b>Examiner</b> George R. Evanisko	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,7-13,15-26,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7-13, 15-26, 28, and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____                                                            | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 10/11/05 is insufficient to overcome the rejection of the claims based upon the Morgan reference as set forth in the last Office action because: the declaration does not include an acknowledgement by the declarant that willful false statements and the lie are punishable by fine or imprisonment, or both (18 USC 1001) and may jeopardize the validity of the application or any patent issuing thereon (see MPEP 715.04).

In addition, the declaration refer(s) only to the system described in the above referenced application and not to the individual claims of the application. The claims do not mention “electrodes”, the size of adult or pediatric electrodes or the universal electrode, and the “operator” setting the mode indicator.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5, 16, 18, 25, and 26 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan et al (6134468). Morgan states in column 4, line 45 that the electrodes used on children are the electrodes ordinarily used on adults. In addition, Morgan provides a presence detect signal in the energy reduction unit that will indicate/identify to the AED and set the particular mode of the device to deliver adult or pediatric energy (the claimed "setting an adult/pediatric mode indicator" for claims 16 and 25) and teaches in column 8 the setting of a switch with the connector. Morgan does not specifically point out the size of his electrode, such as that it is smaller than a conventional adult electrode and larger than a conventional pediatric electrode. It is noted that the size limitations of a conventional adult and pediatric electrode have not been specified and since Morgan's electrode is used on children and adults, Morgan meets the claimed limitations.

In the alternative, Morgan discloses the claimed invention except for the electrode being smaller than a conventional adult electrode and larger than a conventional pediatric electrode (about 50 cm<sup>2</sup>). It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to modify the defibrillation electrode as taught by Morgan, with the electrode being smaller than a conventional adult electrode and larger than a conventional pediatric electrode (about 50 cm<sup>2</sup>) since it was known in the art that a defibrillation electrode is provided that is smaller than a conventional adult electrode and larger than a conventional pediatric electrode (about 50 cm<sup>2</sup>) to effectively deliver the defibrillation pulse to the patient without burning the patient and/or to provide an electrode that can be used on an adult or child.

Claim 7 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan et al. Morgan states that the defibrillator is an automatic defibrillator and will inherently determine whether defibrillation was successful in order to deliver additional shocks if necessary.

In the alternative, Morgan discloses the claimed invention except for the determination of whether defibrillation was successful. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the automatic defibrillator as taught by Morgan, with a determination of whether defibrillation was successful since it was known in the art that defibrillators determine whether defibrillation was successful in order to deliver additional shocks to stop fibrillation.

Claims 8, 9, 11, 12, 13, 17, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. Morgan states that the defibrillator is an automatic defibrillator and will inherently determine whether defibrillation was successful in order to deliver additional shocks if necessary.

Morgan et al discloses the claimed invention except for the determination of whether defibrillation was successful (claims 8, 9, and 11), the particulars energies of the first and second waveforms, and the additional/incremental waveform energies of the second waveform (claims 8, 9, 11-13, and 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pediatric and adult defibrillation method as taught by Morgan, with a determination of whether defibrillation was successful, the particulars energies of the first and second waveforms, and the additional waveform energies of the second waveform since it was known in the art that pediatric and adult defibrillation methods use a determination of whether defibrillation was successful in order to deliver additional shocks to stop fibrillation and since it was known that defibrillators use the particulars energies of the first and second waveforms, and the additional waveform energies of the second waveform to provide an effective waveform for defibrillation of adults and children.

Claims 3, 4, 10, and 15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan et al. It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

In the alternative, Morgan discloses the claimed invention except for the conductive portion of the electrode being a foil with an opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrode with conductive portion as taught by Morgan, with the conductive portion being a foil with an

opening since it was known in the art that defibrillation electrodes with conductive portions make the conductive portion out of a foil with an opening to provide an inexpensive, light, conductive portion that can easily distribute the defibrillation energy.

### ***Response to Arguments***

Applicant's arguments filed 10/11/05 have been fully considered but they are not persuasive. The arguments rely on the declaration of Morgan and are therefore not persuasive since the declaration has not been considered and/or is insufficient. It is noted that the claims only state one "electrode" is coupled to the device and not a pair of "electrodes". In addition, the claims do not set forth the size limitations of the electrodes (the universal electrode or adult or pediatric electrode) and do not state that the operator is setting the mode. The previously cited Heath and Ferrari are two examples of many showing the use of an electrode of approximately 50 cm<sup>2</sup>, which is the size of the applicant's universal electrode. In addition, Heath states in column 13 that the defibrillator electrode cable can contain a shorting jumper so the electrode can be used on a child and therefore Heath also shows an universal electrode.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
George R Evanisko  
Primary Examiner  
Art Unit 3762

11/21/05

GRE  
November 21, 2005